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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,344	09/24/2001	Tamac Hashimoto	Q66385	4620
7590 05/12/2006				
SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue N.W. Washington, DC 20037-3202			EXAMINER LESNIEWSKI, VICTOR D	
			ART UNIT 2152	PAPER NUMBER

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,344	HASHIMOTO, TAMAE	
	Examiner	Art Unit	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 6,9,12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 2/9/2006 has been placed of record in the file.
2. Claims 1 and 5 have been amended.
3. Claims 10-13 have been added.
4. Claims 1-13 are now pending.
5. The applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the following new grounds of rejection.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 2/9/2006 has been entered.

Claim Objections

7. Claims 6, 9, 12, and 13 are objected to because of the following informalities:
 - Claims 6, 9, 12, and 13 make claim to “a storage medium as claimed in claim 5”.However, claim 5 states a recording medium and not a storage medium. For the purpose of applying prior art it will be assumed that claims 6, 9, 12, and 13 refer to a recording medium as claimed in claim 5.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reifman et al. (U.S. Patent Number 5,917,615), hereinafter referred to as Reifman, in view of Kutsumi et al. (U.S. Patent Number 7,010,533), hereinafter referred to as Kutsumi.

10. Reifman disclosed a document transmission apparatus that provides a user interface to allow users to customize document transmissions in such ways as adding a certain cover letter or attaching a stored data file. In an analogous art, Kutsumi disclosed a method for preparing a message that allows a user to insert additional text or graphics into the message.

11. Concerning claims 1 and 5, Reifman did not explicitly state additional information being inserted into a transmittal letter. However, Kutsumi's system allows users to insert additional information into a message instead of just attaching the information to the message. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Reifman by adding the ability to utilize additional information which can be inserted into a transmittal letter as provided by Kutsumi. Here the combination satisfies the need for a messaging system that allows for inserting text or images into the body of a message instead of only attaching them to the message. See Kutsumi, column 2, lines 8-28. This rationale also applies to those dependent claims utilizing the same combination.

12. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a recording medium are rejected under the same rationale applied to the described claim.

13. Thereby, the combination of Reifman and Kutsumi discloses:

- <Claims 1 and 5>

A document transmission apparatus, comprising: a document data transmission section for producing document data; a transmittal letter production section for producing a transmittal letter to be attached to the document data (Reifman, figure 1, items 36 and 38 and column 20, lines 28-31); a transmission section for electronically transmitting the document data with the transmittal letter attached (Reifman, figure 1, item 42); an additional information storage section in which a plurality of pieces of additional information which can be inserted into the transmittal letter are stored (Reifman, column 21, lines 21-22 and Kutsumi, figure 26, item 303); and an operation section for selecting an arbitrary one of the pieces of additional information from within said additional information storage section; said transmittal letter production section producing a transmittal letter in which the additional information selected by said operation section is inserted (Reifman, column 21, lines 24-45 and Kutsumi, column 25, line 12 through column 26, line 40).

- <Claims 2 and 6>

A document transmission apparatus as claimed in claim 1, wherein said operation section includes a display section for displaying the additional information stored in said additional information storage section, and a selection input section for arbitrarily

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selecting the additional information displayed on said display section (Reifman, column 21, lines 24-45 and Kutsumi, column 25, lines 18-61).

- <Claims 3 and 7>

A document transmission apparatus as claimed in claim 2, wherein said additional information storage section stores a registration number and a title for each of the pieces of additional information and said display section displays at least the registration numbers and the titles of the pieces of additional information as a list, and said selection input section designates one of the displayed registration numbers to select the additional information and said transmittal letter production section inserts a text of the selected additional information into the transmittal letter (Reifman, column 21, lines 17-32 and Kutsumi, column 36, lines 26-39; column 39, line 65 through column 40, line 3; and column 24, lines 32-35, where it would have been obvious to also display the indices or registration numbers).

Although the combination of Reifman and Kutsumi does not explicitly display registration numbers, the system does display lists of illustrations or illustration attribution values (such as titles) to allow the user to choose the appropriate illustration. Thus it would be obvious to display registration numbers (or indices) to allow the user to choose the appropriate illustration since a registration number is simply another type of illustration identifier. The use of numbers as file labels or identifiers was well known in the art at the time of the applicant's invention.

- <Claim 4>

A document transmission apparatus as claimed in claim 1, further comprising additional information registration means for additionally storing new additional information into said additional information storage section (Reifman, column 20, lines 61-67 and Kutsumi, column 26, lines 52-57).

- <Claims 8 and 9>

A document transmission apparatus as claimed in claim 1, wherein a user selects the additional information to insert into said transmittal letter (Reifman, column 21, lines 33-45 and Kutsumi, column 25, lines 18-61).

- <Claims 10 and 12>

A document transmission apparatus as claimed in claim 1, wherein text of the additional information is inserted into the transmittal letter (Kutsumi, column 25, line 12 through column 26, line 40 and column 39, line 65 through column 40, line 3).

- <Claims 11 and 13>

A document transmission apparatus as claimed in claim 1, wherein the transmission section electronically transmits the document data and attached transmittal letter, the attached transmittal letter including text of the additional information inserted within (Reifman, column 19, lines 37-44 and Kutsumi, column 26, lines 23-40).

Since the combination of Reifman and Kutsumi discloses all of the above limitations, claims 1-13 are rejected.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.


- Levine et al. (U.S. Patent Number 4,445,795) disclosed an interactive text processing system for creating documents by selectively merging text data from two or more text records.
- Powers (U.S. Patent Number 6,446,115) disclosed a method for adapting a piece of correspondence with integrated graphical correspondence content.

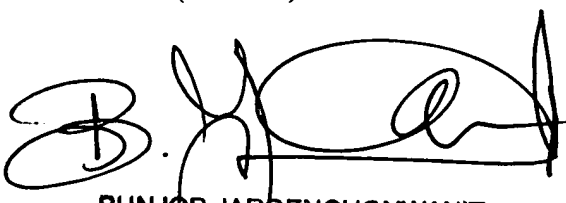
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor Lesniewski
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SUPERVISORY PATENT EXAMINER